



20 AUG 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

MORGAN & FINNEGAN  
345 Park Avenue  
New York, NY 10154

In re Application of:	:	
MURAKAMI, Kazuo, et al.	:	
U.S. Application No.: 09/926,144	:	DECISION ON PETITION TO
PCT No.: PCT/JP00/08761	:	WITHDRAW HOLDING OF
International Filing Date: 11 December 2000	:	ABANDONMENT
Priority Date: 17 December 1999	:	
Atty Docket No.: 5000-4943	:	
For: COMPRESSOR AND METHOD OF	:	
LUBRICATING THE COMPRESSOR	:	

This decision is issued in response to the "Request For Withdrawal Of Improper Notice Of Abandonment" filed 23 January 2004 and treated herein as a petition under 37 CFR 1.181. No petition fee is required.

**BACKGROUND**

On 11 December 2000, applicants filed international application PCT/JP00/08761 which claimed a priority date of 17 December 1999 and which designated the United States. The deadline for submission of the basic national fee was twenty months from the priority date, i.e., 17 August 2001.

On 07 September 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a translation of the international application into English, and a petition to revive the international application under 37 CFR 1.137(b).

On 20 December 2001, this Office issued a decision granting applicants' petition to revive the application. The decision stated that the application file was "being returned to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an executed declaration in compliance with 37 CFR 1.497."

Pursuant to the 20 December 2001 decision, on 01 February 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration was required.

On 07 October 2002, applicants filed, among other materials, a Status Request that stated that applicants had received no further Communications from the Office after the 20 December 2001 decision. The 07 October 2002 submission did not include an oath or declaration.

On 04 December 2003, the DO/EO/US mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification Of Missing Requirements mailed 01 February 2002.

On 23 January 2004, applicants filed the petition considered herein. The petition asserts that applicant did not receive the originally mailed Notification Of Missing Requirements, and that the holding of abandonment should therefore be withdrawn.

### **DISCUSSION**

Section 711.03(c)II of the MPEP sets forth the requirements for a grantable petition to demonstrate the failure to receive an Office communication:

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact the a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

Here, the petition contains the required statements from practitioner that the Notification Of Missing Requirements was not received and that a review of the file and docket records indicates that the Notification was not received.

With respect to the docket records requirement, applicants have provided a docket record with respect to this particular application; this record does not indicate receipt of the Notification Of Missing Requirements. However, the docket record provided does not satisfy the docket records requirement for a grantable petition. Applicant is required to provide a copy of the office docket for counsel's office for the date a response to the Notification was due, i.e., 01 April 2002.

Based on the above, applicants have failed to satisfy all the requirements for a grantable petition. Accordingly, at the present time, it cannot be concluded that the Notification Of Missing Requirements was not received by applicant.

It is noted that applicants still have not submitted the materials required by the Notification Of Missing Requirements, i.e., an oath or declaration in compliance with 37 CFR 1.497.

**CONCLUSION**

Applicants' petition under 37 CFR 1.181 is **DISMISSED** without prejudice. The application remains abandoned.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181" and must include the required docket records, as discussed above.

A courtesy copy of the Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 01 February 2002 is enclosed herewith.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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Encl.:  
Notification Of Missing Requirements (Form PCT/DO/EO/905), mailed 01 February 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

 Commissioner for Patents, Box 101  
 United States Patent and Trademark Office  
 Washington, D.C. 20503  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY DOCKET NO.
09/926,144	Kazuo Murakami	5000-4943

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 MORGAN & FINNEGAN, L.L.P.  
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INTERNATIONAL APPLICATION NO.	
PCT/JP00/08761	
LA FILING DATE	PRIORITY DATE
12/11/2000	12/17/1999

 CONFIRMATION NO. 9479  
 371 FORMALITIES LETTER


\*OC000000007371438\*

Date Mailed: 02/01/2002

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated Office (37 CFR 1.494):

- U.S. Basic National Fees
- Priority Document
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Preliminary Amendments
- Request for Immediate Examination

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

## BEST AVAILABLE COPY

*A copy of this notice **MUST** be returned with the response.*

MAMIE P PERSON

Telephone: (703) 305-3737

PART 2 - OFFICE COPY

U.S. APPLICATION NUMBER NO	INTERNATIONAL APPLICATION NO.	ATTY DOCKET NO
09/926,144	PCT/JP00/08761	5000-4943